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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 08/994,363
Filing Date: December 19, 1997
Appellant(s): GARRISON ET AL.

Alfred A. Stadnicki
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 14, 2004.

(1) *Real Party in Interest*

A statement identifying the real party in interest is contained in the brief.

(2) *Related Appeals and Interferences*

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) *Status of Claims*

The statement of the status of the claims contained in the brief is correct.

(4) *Status of Amendments After Final*

No amendment after the final rejection of 10/6/03 has been filed.

(5) *Summary of Invention*

The summary of invention contained in the brief is correct.

(6) *Issues*

The appellant's statement of the issues in the brief is correct.

(7) *Grouping of Claims*

The grouping of the claims are defined at page 7, section IX, line 6 and are accepted.

(8) *Claims Appealed*

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) *Prior Art of Record*

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

Art Unit: 2165

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-8, 10-13, 15-18 and 20-24 are rejected under 35 U.S.C. 102(e) as being anticipated by Kolling et al. (U.S. Patent 5,920,847).

Claim 1: Col. 15, lines 55-60 of Kolling et al. describe the creation of a payor (consumer) request to make a payment to a payee (biller). The request is the bill pay order (122). As seen in FIG. 4, the payment request is processed and passes through a plurality of remittance centers (Bank C and Bank B). The payor request includes a payor account number (The BRN---a biller reference number placed by the biller on the consumer's bill). The payor request is received at a Bank C (as seen in FIG. 4) and then processed by a payment network (102) which utilizes a database (108) to identify and select a specific remittance center (Bank B) to direct the consumer's funds (col. 16, lines 43-50; and col. 17, lines 15-24).

Claim 2: The account number (BRN) is processed by using a look-up table at the payment network to identify a single remittance center (Bank) to which the funds are supposed to be directed.

Claim 3: The account number (BRN) is described as being formed by numerical digits (col. 15, line 43). Numeric digits are a type of alphanumeric character, and read on the

Art Unit: 2165

requirement for alphanumeric characters. Also note that Kolling et al. allows for “non-numeric BRN’s” (col. 15, line 44), further suggesting the presence of alphanumeric characters.

Claim 5: Col. 17, lines 15-24 and col. 18, lines 59-63 describe a process in which the account number (BRN) is altered by adding additional information to the account number in a payment message. In particular, the account number (BRN) is altered by referencing a database (108) and obtaining a Bank ID for Bank B. The bank ID is then added to the account number in a payment message directed to the biller’s (payee’s) bank. The alteration rule is the Bank ID which must be added to the account number in order to create the payment message (124).

Claim 6: See remarks for claim 1. The communicative interface configured to receive the payor request is the Bank C in FIG. 4. The processor configured to process the account number is the payment network (102).

Claim 7: See remarks for claim 2.

Claim 8: See remarks for claim 3.

Claim 10: Col. 17, lines 15-24 and col. 18, lines 59-63 describe a modification process performed by a modification unit in which the account number (BRN) is altered at payment network (102) by adding a Bank ID so as to create a payment message. Once the payment message is created, a verification process can be performed (col. 16, lines 29-32) on the message to assure its validity before the message gets passed on to a particular remittance center (Bank B).

Claim 11: See remarks for claim 1. Note that the process is carried out by a programmed computer system.

Claim 12: See remarks for claim 2.

Claim 13: See remarks for claim 3.

Claim 15: See remarks for claim 5.

Claim 16: FIG. 4 illustrates a communications network. A first network station (consumer C) generates a payor's payment information (bill order 122). This order includes (see col. 15, lines 55-60) at least an account number (BRN), payee name (an authorization to pay a specifically identified biller having the BRN) and address data prepared by the payor (the customer's account number). The payor's payment information is communicated to the network. A second network station (102) receives a payment message (124) containing the payor's payment information and processes the account number by looking up an identification of Bank B, which is one of the plurality of remittance centers in the system. A payment message then gets directed to Bank B.

Claim 17: The account number (BRN) is used as a key to lookup the identification of the remittance center used by the biller. Since the BRN can be directly correlated to the desired remittance center (Bank B), any information within the BRN reads as a characteristic that identifies the desired remittance center (Bank B).

Claim 18: See remarks for claim 3.

Claim 20: See remarks for claim 5.

Claims 21-24: As seen in FIG. 4, the payment is ultimately directed to remittance center identified as "Bank B". However, the payment messages pass through other remittance centers enroute, including Bank C and the payment network (102).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

Art Unit: 2165

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 14 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kolling et al.

Claims 14 and 19: With respect to each of claims 14 and 19, Kolling et al. discloses a BRN, which corresponds to the claimed "account number". Col. 15, lines 39-45 of Kolling et al. describe the BRN as having "n-number" of digits, where each digit can range between 0-9. Although Kolling et al. does not specifically call out the usage of 11 digits for the BRN, forming the BRN as 11 digits instead of 9 would have been obvious to one of ordinary skill in the art as a specific choice of design, particularly since Kolling et al. allows the BRN to be any length.

Accordingly, as applied to claims 14 and 19, the step creating payment messages (124) containing the BRN would read as the step of "processing the information" to produce a message having the 11 digit code. The particular entity which creates the payment message thus reads as the "mapping unit". This payment message is then sent to the payment network (102) where the code is used to access the database (108) which can then identify a specific biller based on the code. The entity which performs this database access (typically, it would be the network 102) would be the "retrieval unit".

Claims 4 and 9 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

(11) Response to Argument

Preliminary Note: Appellant's arguments directed to the same claims appear at different points within appellant's arguments and are not sequentially presented. When addressing specific claims, the page number and section of appellant's brief being considered will be indicated.

Claims 1-3, 5 and 21: Appellant argues (page 11, third paragraph through end of page 12) the feature set forth in claim 1 calling for a "payor account number" associated with the payee. Appellant takes issue with the examiner's correlation of the payor account number with the BRN disclosed in Kolling et al. In particular, appellant argues that the BRN identifies the biller not the payee and is not unique to the payor. Examiner has considered both of these arguments, but finds that neither is supported by the actual claim language. The term "payor account number" does not require a unique identification of one specific party, a unique association to the payor, be exclusive to the payor or different from all other account numbers. The claim language in claim 1 clearly makes no such requirements. In the broadest reasonable sense, the "payor account number" is some number associated between the payor and payee. This is directly supported in appellant's specification, where the term "payor account number with the payee" (page 7, line 3) is the only elaboration on this term that is ever provided. The claim itself does not define the meaning of this term. The BRN is provided to the payor in the initial bank statement (38 in FIG. 4 and col. 15, line 47) and also appears on the bill pay order (122 in FIG. 4 and col. 15, lines 55-60) from the payor. Being that this account number is provided to the payor in the initial bill and provided by the payor in making the payment to the payee (the Biller B), there is a clear association between the payor, the BRN number and the payee. This is consistent with the payor account number discussed in the specification. Appellant

Art Unit: 2165

also argues (page 16, last two lines) that Kolling et al. lacks a payee and a plurality of remittance centers and an account number to select a single remittance center. This argument is not correct. Kolling et al. discloses (in FIG. 4) a payor (Consumer C), remittance centers (Bank C and Bank B) and an account number BRN that will uniquely identify bank B as the bank for the payee (biller). Appellant presents additional arguments for claim 21 at page 13, third paragraph through the end of page 14. These arguments have been considered but are not deemed correct. FIG. 4 of Kolling et al. clearly discloses other remittance centers besides the biller's bank B, including the settlement bank (128) and the distinct the payment network (102). These features are clearly taught in FIG. 4 of Kolling et al.

Claims 6-8, 10 and 22: Appellant presents arguments for claim 6 at page 9, third paragraph through page 12. These arguments are identical to those for claim 1 as addressed above. Additional arguments for claim 6 appear at page 17, lines 2-4. Appellant argues that Kolling et al. lacks a plurality of remittance centers and a processor that selects a single remittance center. This argument has been considered but is not correct. FIG. 4 of Kolling et al. discloses a plurality of remittance centers (Bank C and Bank B) and a processor (102) that can select a single remittance center (Bank B) in which to direct the consumer's payments. Appellant presents additional arguments for claim 22 at page 13, third paragraph through the end of page 14. These arguments are the same as those for claim 21, discussed above.

Claims 11-15 and 23: Appellant presents arguments for claim 11 at page 9, third paragraph through page 12. These arguments are identical to those for claim 1 as addressed herein. Additional arguments for claim 11 appear at page 17, third paragraph. Appellant argues that Kolling et al. lacks a payee, a plurality of remittance centers and a stored computer program

Art Unit: 2165

to cause a computer to process an account number to identify a single remittance center. However, Fig. 4 of Kolling et al. discloses both payor (Consumer C) and payee (Biller B), a plurality of remittance centers (Bank C and Bank B) as well as stored computer programming (the programming within the system 102, the programming of subsystems 104 and 106) which acts to use the account number (BRN) to identify the Biller B and then direct payment from the payor to the remittance center (Bank B) associated with the Biller B. Appellant presents additional arguments for claim 23 at page 13, third paragraph through the end of page 14. These arguments are the same as those for claim 21, discussed herein.

Claims 16-20 and 24: Appellant presents arguments for claim 16 at page 9, third paragraph through page 12. These arguments are identical to those for claim 1 as addressed herein. Additional arguments for claim 16 appear at page 17, fourth paragraph. Appellant argues that Kolling et al. lacks a second network station representing a payment service provider for processing the account number to identify a single remittance center. However, Kolling et al. discloses multiple network stations, a second of which is station (102) which represents a payment service provider and which receives payment information and which uses the BRN account number to identify a single remittance center (Bank B) as the recipient of funds from a consumer. Appellant presents additional arguments for claim 24 at page 13, third paragraph through the end of page 14. These arguments are the same as those for claim 21 discussed herein.

Claims 14 and 19: Appellant presents additional and separate arguments for claims 14 and 19 at page 20, last two paragraphs, and additional arguments in reference to obviousness in general at pages 17-22. These arguments appear to be very highly generic in nature, and appear

Art Unit: 2165

to be more along the lines of general allegations of impermissible hindsight rather than any specific considerations of the issues of obviousness raised by the examiner. The issues of obviousness raised by the examiner pertains to the obviousness of using an 11 digit BRN as opposed to the disclosed 9 digit BRN. Examiner maintains that such a modification to an identification would have been obvious to the person of ordinary skill in the art, and the arguments presented do not appear to address this specific issue of obviousness.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,




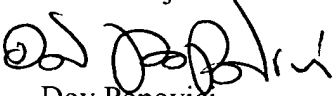
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Art Unit 2165

March 30, 2005

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